

Remarks

Applicants hereby add claims 21-29. Accordingly, claims 1-29 are pending in the present application.

Claims 1-3, 5-8, 11, and 13-16 stand rejected under 35 USC 102(b) for anticipation by Monroe. Claims 4, 9-10, 12, and 17-20 stand rejected under 35 USC 103(a) for obviousness over Monroe.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to the rejection of claim 1, the claim now recites the *firmware upgrade information comprises information configured to effect at least one operation of a printer of the printing system with respect to the formation of a hard image upon media using the printer.* At page 2 of the 10/06/03 Office Action (subsequently referred to as the first Office Action), it is alleged that paragraph 0089 of Monroe teaches retrieval and installation of firmware. However, the identified teachings merely state that the remote device may be used for remote loading and downloading of firmware. The remote loading and downloading of firmware of Monroe fails to teach or suggest the claimed firmware upgrade information configured to effect any operation of a printer or other hard imaging device with respect to the formation of a hard image. Page 2 of the first Office Action further alleges that Monroe teaches "firmware of a camera or fax of the front figure." Applicants disagree and have electronically searched and have failed to uncover any teaching or suggestion in Monroe that the firmware relates to a fax. It follows that Monroe fails to disclose or suggest the claimed *retrieval and installation of the firmware upgrade information configured to effect at least one operation of the printer of the printing system with respect to the formation of a hard image upon media using the printer* as claimed.

In addition, referring to page 2 of the 1/29/04 Office Action (subsequently referred to as the second Office Action), Applicants assert that even if the system of Monroe discloses a fax, Monroe is entirely devoid of disclosing or suggesting that the firmware of paragraph 0089 is used by the fax let alone the limitations of now pending claim 1 with respect to the firmware upgrade information configured to effect an operation of a printer with respect to the formation of the hard image.

Positively recited limitations of claim 1 are not shown nor suggested and

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claim 1 is allowable for at least this reason.

In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable.

In particular, if claim 1 is not allowed, Applicants respectfully request identification of specific prior art teachings relied upon as allegedly disclosing the firmware upgrade information as now defined in claim 1 in accordance with the CFR and MPEP.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 5, Applicants thank the Office for the identification of Monroe teachings on page 3 of the first Office Action in support of the rejection of claim 5. Such identified teachings are clearly directed towards utilization of triggering events for capturing images using the camera and transmitting the images. However, Applicants note that claim 5 recites *trigger means for actuating the automatic remote firmware update mechanism to automatically retrieve firmware upgrade information when the update trigger parameter reaches a predetermined update value*. The capturing and transmitting of images fails to disclose or suggest the limitations of claim 5 regarding retrieval of firmware upgrade information and claim 5 is allowable for at least this reason.

Applicants note that these recited passages of Monroe were also relied upon in support of the rejections of claims 6-8 and 13-16. These additional claims are also allowable in view of the failure of Monroe to teach or suggest the respective claimed limitations.

Referring to claim 9, the claim stands rejected under 103 only over Monroe. The second Office Action presents additional references to support the allegation that the reference teachings are well known. However, MPEP §2143.01 states a statement that modifications of the prior art to meet the claimed invention in view of being allegedly well within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art *is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references*. Despite Applicants' previous request for proper motivation after the first Office Action, as of yet none has been provided by the Office contrary to the MPEP. The obviousness rejection against claim 9 is improper and must be withdrawn at least in consideration of the MPEP. Claim 9 is allowable.

Referring to claim 11, the claim now recites *selectively installing firmware upgrade information into firmware of a printer of the printing system*. Monroe fails to disclose or suggest any teachings regarding where communicated firmware is to be installed. The first and second Office Actions fail to recite any specific teachings regarding installation of downloaded firmware. Further, Applicants have electronically searched and failed to uncover any teachings regarding installing firmware upgrade information into firmware of a printer or any other structure which may be fair interpreted to disclose or suggest a printer. In addition, there is no motivation to modify the teachings of Monroe to arrive at Applicants' claim 11 invention. Positively-recited limitations of now-pending claim 11 are not shown nor suggested by the art and claim 11 is allowable for at least this reason.

The claims which depend from independent claim 11 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 19 a printer is defined. Claim 19 further recites an *automatic remote firmware update mechanism adapted to retrieve firmware upgrade*

information and to install the firmware upgrade information into the firmware of the printer. Monroe fails to disclose or suggest details regarding installation of firmware let alone Applicants' claimed installation into the firmware of the printer as positively-recited in claim 19. Accordingly, claim 19 recites limitations which are not shown nor suggested by the prior art and claim 19 is allowable for at least this reason.

Pursuant to the MPEP and CFR sections recited above, Applicants' respectfully request identification of prior art teachings relied upon in support of any rejection of claim 19 in a non-final action if claim 19 is not allowed so Applicants' may appropriately respond.

The claims which depend from independent claim 19 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Support for the new claims may be found at least at pages 5-7 of the originally-filed application and the associated drawings.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
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By: 

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